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09/710,181	11/10/2000	Steven D. Jensen	7678.350.2	4245

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EXAMINER

PRYOR, ALTON NATHANIEL

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1616

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/710,181
Filing Date: November 10, 2000
Appellant(s): JENSEN ET AL.

MAILED
FEB 12 2007
GROUP 1600

John M. Guynn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/12/06 appealing from the Office action mailed 8/23/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Office action dated 4/5/05 recites that Applicant does not provide ample data for the claimed range of peroxide being from 0.5 – 50%.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Patent 6,306,370 and U.S. Patent 6,309,625 are references relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41,42,44-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8,10,11,13-26 of U.S. Patent No. 6309625. Although the conflicting claims are not identical, they are not patentably distinct from each other because Fischer claims (USPN 6309625) a composition comprising peroxides such as carbamide peroxide and hydrogen peroxide plus 0.1-50 % potassium nitrate. The composition can further comprise 0.5-20 % carboxypolymethylene, 20-85% polyol such as glycerine, up to 50 % water, active agents such as sodium fluoride and tetracycline, and stability enhancers such as EDTA. Applicant's specification (USPN 6309625) teaches that the amount of peroxide ranges from 0.5-50 %. See column 9 lines 40-54. Fischer's invention (USPN 6309625) also claims a method to bleaching teeth with the composition with the aid of a tray. Fischer's

Art Unit: 1616

invention (USPN 6309625) discloses amounts of potassium nitrate (0.1-50 %) and peroxide (0.5-50 %), which encompass instant amounts of potassium nitrate and peroxide. Fischer's invention (USPN 6309625) also claims a method to bleaching teeth with the composition with the aid of a tray. For this reason, it would have been obvious to one having ordinary skill in the art at the time the prior art invention was made to employ the instant amounts of potassium nitrate and peroxide. One would have been motivated to do this since the USPN 6309625 amounts overlap the instant amounts. Applicant points out in a declaration and a working example that 10.5 % and 15 % carbamide plus 0.5 % potassium nitrate yields unexpected data. Applicant also refers Examiner to examples 3-10 in instant specification, which suggest 0.01-2% potassium nitrate yields unexpected results. Examiner is in agreement with Applicant's results. However, the Examiner argues that the declaration is not commensurate in scope with claims because the claims recite a range of 0.5-50% peroxide and applicants' declaration only shows results for ranges of peroxide being 10% or 15%.

Claims 41,42,44-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6306370. Although the conflicting claims are not identical, they are not patentably distinct from each other because Fischer (USPN 6306370) claims a composition comprising 3-20 % peroxides such as carbamide peroxide and hydrogen peroxide plus 0.1-10 % potassium nitrate. The composition can further comprise carboxypolymethylene, polyols such as glycerine, up to 50 % water, active agents such as sodium fluoride and tetracycline, and stability enhancers such as EDTA. Fischer's

Art Unit: 1616

invention (USPN 6306370) also claims a method to whitening (bleaching) teeth with the composition with the aid of a tray. Fischer's invention (USPN 6306370) discloses amounts of potassium nitrate (0.1-10 %) and peroxide (3-20 %), which encompass instant amounts of potassium nitrate and peroxide. Fischer's invention (USPN 6306370) also claims a method to bleaching teeth with the composition with the aid of a tray. For this reason, it would have been obvious to one having ordinary skill in the art at the time the invention (USPN 6306370) was made to employ the instant amounts of potassium nitrate and peroxide. One would have been motivated to do this since the USPN 6306307 amounts overlap the instant amounts. Applicant points out in a declaration and a working example that 10.5 % and 15 % carbamide plus 0.5 % potassium nitrate yields unexpected data. Applicant also refers Examiner to examples 3-10 in instant specification, which suggest 0.01-2% potassium nitrate yields unexpected results. Examiner is in agreement with Applicant's results. However, the Examiner argues that the declaration is not commensurate in scope with claims because the claims recite a range of 0.5-50% peroxide and applicants' declaration only shows results for ranges of peroxide being 10% or 15%.

(10) Response to Argument

I. Rejection of claims 41,42,44-87 over obviousness-type double patenting with respect to USPN 6309625 will not be maintained. Appellant is correct in that the claims in USPN ' 625 makes no suggestion to dental bleaching composition comprising 0.5 to 50% peroxide.

Art Unit: 1616

II. Rejection of claims 41,42, 44-87 over obviousness-type double patenting with respect to USPN 6306370 will be maintained for reason on record and reason as follows.

Appellants make several arguments as to why the rejection should be withdrawn. Appellants provide declarations to support their position. Appellant also points out that a double patenting rejection is over the claims not the body of the disclosure.

The Examiner agrees with the point made by the Appellant that a double patenting rejection is over the claims not the body of the disclosure. For this reason the double rejection over USPN '625 is withdrawn, and for the same reason the double rejection over USPN '370 is maintained.

A) Note that Appellants' claims are to a dental bleaching composition comprising:

- 1) about 0.5 to about 50 % peroxide as to have a tooth bleaching effect;
- 2) about 0.01 to about 2 % potassium nitrate as to result in reduced tooth sensitivity that may be caused by the peroxide; and
- 3) a carrier.

B) Note that USPN '370 makes claim (see claim 14) to a dental bleaching composition comprising:

- 1) about 3 to about 20% peroxide;
- 2) about 0.01 to about 10% potassium nitrate in an amount to reduce tooth sensitivity that may be caused by the peroxide; and

3) a carrier.

In the comparison of Appellants' claims with USPN '370 claims, the claims in USPN '370 makes obvious instant claims. Note instant claims to composition comprising about 0.5% to about 50 % peroxide encompasses instant peroxide range of about 3% to about 20% peroxide. Note that instant claims to composition comprising about 0.01 to about 2 % potassium nitrate fall within the range (about 0.01 to about 10%) claimed in USPN '370. Therefore, USPN '370 claims makes obvious the instant claims. Appellant provides unexpected for a composition comprising 10 or 15 % peroxide and 0.5 % potassium nitrate (see evidence appendix). As recited in office action of 4/5/2005, the Examiner agrees that results are convincing as well as unexpected. However, the Examiner maintains that the claims are not commensurate in scope with the claimed range of peroxide being about 0.5 to about 50%. Note that Appellants instant claimed range of peroxide is boarder than the range claimed in USPN '370. For this reason, the rejection is maintained. Appellant argues that the criticality of the invention lies within the amount of potassium nitrate not in the amount of peroxide. This may be true, however, this statement is not convincing since Appellant only provides data for 10% and 15% peroxide in the broad range of about 0.5 to about 50% peroxide instantly claimed. For the above reasons USPN '370 is cited as an obviousness-type double patenting rejection over instant claims. To maintain clarity that the obviousness type double patenting rejection is maintained due to claimed subject matter in instant claims versus claims in USPN '370, arguments with respect to Examples 7 and 14 in USPN '370 will not be entertained.

Art Unit: 1616

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Alton Pryor

Primary Examiner, AU 1616

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